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09/441,987	11/17/1999	MARK ALAN BURAZIN	13.497.2	5262

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EXAMINER

CHEVALIER, ALICIA ANN

ART UNIT	PAPER NUMBER
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1772

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/441,987

Filing Date: November 17, 1999

Appellant(s): BURAZIN ET AL.

Gregory Croft
For Appellant

EXAMINER'S ANSWER

MAILED
DEC 13 2004
GROUP 1700

This is in response to the appeal brief filed June 1, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

The double patenting rejection over Patent No. 6,077,590 in view of Wendt et al. (U.S. Patent No. 5,672,248) of claims 49-69 of record in paper #17, page 3, paragraph #6 is withdrawn due to Applicant's arguments.

(7) Grouping of Claims

Appellant's brief includes a statement that claims stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,077,590	ARCHER et al.	06-2000
5,672,590	WENDT et al.	09-1997

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. Claims 1-22, 70 and 71 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the

claimed invention. In the instant case amended claims 1, 7, 11 and 16 contain the limitation "non-embossed tissue basesheet". The specification does not disclose that the basesheet is not embossed, therefore this limitation is considered new matter.

Any negative limitation or exclusionary proviso must have basis in the original disclosure. See *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), aff'd mem., 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. MPEP § 2173.05(i)

Claim Rejections - 35 USC § 103

2. The 35 U.S.C. §103 rejection of claims 48-69 as over Wendt et al (U.S. Patent No. 5,672,248) in view of Archer et al. (U.S. Patent No. 6,077,590).

Wendt et al. discloses creped or uncreped (*col. 2, lines 23-27*) throughdried tissue sheets with a bulk of about 13 to about 20 cubic centimeters per gram (*col. 3, lines 39-41*), where the bulk is defined as the caliper of a single ply of product divided by its basis weight (*col. 3, lines 40-42*). Furthermore, such tissue sheets having a basis weight in the range from about 10 to about 70 grams per square meter (*col. 3, lines 51-53*), which makes a single sheet caliper about 0.013 to about 0.14 centimeters, which is approximately 0.005 to 0.05 inches. The tissue also has a geometric mean modulus, or (geometric mean slope)/(geometric mean tensile strength), of less than 5 (*figure 6 and col. 10, lines 27-46*). Also, the tissue sheets have an absorbent capacity of about 11 grams of water per gram of fiber or greater (*col. 3, lines 66 bridging col. 4, line 2*). Since the absorbent rate of the tissue is determined by basically the same procedure as the absorbent capacity (see specification page 6, line 31 bridging page 7, line 10) and Wendt discloses the same method of determining the absorbent capacity with similar results and teaches

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almost all of the Applicant's claimed features, the limitation of the "absorbent rate of about 4 seconds or less" is considered to be an inherent property.

Wendt discloses all the limitations of the instant claimed invention except for the roll form, roll bulk, roll firmness, roll bulk/roll firmness ratio and the roll bulk/roll firmness ratio/single sheet caliper ratio.

Archer discloses a process of embossing and winding a tissue into a roll to obtain a roll bulk of from about 14 cc/g to about 20 cc/g (*col. 1, lines 59-63*) and a roll firmness from about 6 to about 10 mm (*col. 1, line 65-67*). This would produce a roll bulk/roll firmness ratio of about 20-25 cm²/g. Archer's process is aimed at increasing the bulk and strength of the final product (*col. 1, lines 27-33*).

Wendt and Archer are analogous because they both disclose through dried tissue products used for facial tissue, bath tissue and paper towels or the like.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the process of Archer on the tissue of Wendt in order to increase the bulk of the tissue. One of ordinary skill in the art would have been motivated to increase the bulk of the tissue because it would increase the strength of the tissue. It is desirable to have a high bulk because it increases the strength of the tissue for use in household products. Furthermore, the combination of Archer and Wendt would yield a roll bulk/roll firmness ratio/single sheet caliper ratio of about 142 to 1795 cm/g, based upon the roll bulk and roll firmness obtained by Archer and the single sheet caliper of Wendt.

(11) Response to Argument

3. Appellant's arguments in the Appeal Brief filed June 1, 2004 regarding the double patenting rejection over Patent No. 6,077,590 in view of Wendt of record have been considered but are moot since the rejection has been withdrawn.

4. Appellant's arguments in the Appeal Brief filed June 1, 2004 regarding the 35 U.S.C. 103 rejection over Wendt in view of Archer of record have been carefully considered but are deemed unpersuasive.

Appellant argues that that it would not be obvious to combine the teachings of Archer with Wendt because the teachings of Archer are directed solely to "creped" basesheets and Wendt teaches uncreped and throughdried basesheets.

First, it is noted that Wendt discloses a creped or uncreped (*col. 2, lines 23-27*) throughdried tissue sheets. The teaches of Wendt do not show a difference between creped and uncreped sheets. Second, Archer discloses a *process of embossing and winding* aimed at increasing the bulk and strength of the final product (*col. 1, lines 27-33*). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the process of Archer on the tissue of Wendt in order to increase the bulk of the tissue. One of ordinary skill in the art would have been motivated to increase the bulk of the tissue because it would increase the strength of the tissue. It is desirable to have a high bulk because it increases the strength of the tissue for use in household products.

Furthermore, Appellant has only provided "likely scenarios" of why the embossing and winding process disclosed by Archer is unusable with the basesheet of Wendt, not *evidence*. The arguments of counsel cannot take the place of evidence in the record. An assertion of what seems

to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness.

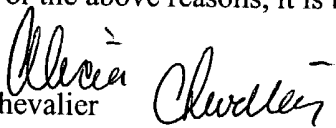
5. Appellant's arguments in the Appeal Brief filed June 1, 2004 regarding the 35 U.S.C. 112-first paragraph rejection have been carefully considered but are deemed unpersuasive.

Appellant admits that the words "non-embossed tissue basesheet" are not in the specification (*Brief page 4, last two lines*). However, Appellant argues that there is sufficient teaching to reasonably conclude that Appellant was in possession of the non-embossed tissue sheet as amended in the amendment filed, August 21, 2003.


Appellant's argument centers around the fact that the process of making a roll of tissue disclosed in their specification does not have an embossing step.

First, the mere absence of a positive recitation is not basis for an exclusion. The specification is completely silent about embossing. Second, Appellant's arguments why embossing would probably not work, Appellant has not presented evidence, in their process is moot since Appellant is not claiming the method of making the tissue, see claim 48.

For the above reasons, it is believed that the rejections should be sustained.



Alicia Chevalier
December 8, 2004

Respectfully submitted,

Conferees
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